

Appl. No. 09/826,408
Amdt. Dated September 15, 2005
Reply to Office Action of June 16, 2005

Attorney Docket No. 81752.0105
Customer No. 26021

REMARKS/ARGUMENTS

Claims 1-37 and 41-43 are pending in the Application. As described hereafter, the claims are submitted to clearly distinguish patentably over the prior art.

In the Final Office Action of June 16, 2005, all of the claims are rejected on prior art. The rejections are based on JP 09-039347 of Furuya et al., taken alone and in combination with other references. These rejections are essentially the same as were made in the prior Office Action of November 4, 2004. Again, such rejections are respectfully traversed.

In lines 8-10 of page 3 of the Final Office Action, the Examiner admits that the desired configuration information, which is set by a user, and the type of the information contained in the desired configuration information is different from what Furuya teaches. The discussion therein then continues that the explanation of the "desired configuration information" is not sufficient to clearly determine what kind of information is being claimed.

However, it has been long established that if the claim language is not clear enough in determining its scope, the invention is defined by the claims but is described, explained and disclosed by the specification. Thus, in Deller's Patents Claims, at page iv of the Preface, the court in Curtiss v. Janin is quoted as stating that "All patentable inventions are defined by claims, but described, explained and disclosed by the specification". And at the last portion of Section 406, Deller notes that "the court explained the function of the specification and the function of the claims" in Curtiss v. Janin with the statement "All patentable inventions are defined by the claims, but described, explained and disclosed by the specification" again being set forth. And in Section 416 of Deller, reference is made to an example in which the examiner rejected claims as not definitely distinguishing from the

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Davis patent in that it is not understandable what might be embraced in the term "normal" used in the claim. This is similar to the present situation at hand. Deller then goes on to quote the Board of Appeals as saying "It seems to us that the purport of this term is obvious, especially when the claim is considered in the light of the specification". As further stated therein, "These claims read in the light of the specification seem to us sufficiently definite to distinguish from the Davis patent and to warrant allowance". In Section 285 of Deller, similar comments are made. As set forth therein, it is noted that the Court stated "The word 'small' might . . . be considered indefinite and to lack particularity and distinctness, but in the light of those portions of the specification of . . ., cannot . . . properly be subjected to that criticism." Copies of the appropriate portions of Deller which are discussed above are enclosed herewith.

In view of the long standing practice of claim interpretation as exemplified by Deller, rejection of the claims and the manner of construing the function of the claims, in the Final Office Action, is contrary to conventional practice.

Moreover, the difference between the claimed terms "desired configuration information" and the teaching of Furuya must be apparent. The terms in question are defined in various parts of the specification. At lines 1 and 2 of page 2 of the present Application, it is stated "information (desired configuration information) which the user can set as he desires". This is again exemplified as "information of type faces, such as Times New Roman and Courier New, or decorations, such as hollowing, italicizing, emphasizing, etc.". (See the last three lines of page 1 and the first line of page 2 of the specification).

The above information is recited in contrast to the conventional art information, such as "information (for instance, the maximum count of lines to be input, required print energy, amount of ink, etc.) related to physical properties of a tape cartridge mounted therein (see the seventh through the fourth lines from the

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bottom of page 1 of the specification). More explanations are provided in the last paragraph of page 46 of the specification, where it is stated:

“When the selection key 323 is depressed by the user in the above state (D17), ‘Courier New’, ‘Normal’ (‘italicizing’ is not applied), ‘hollowing (required)’, and ‘emphasizing (not required)’, which are the items of information (desired configuration information) set in the pattern setting process, are finally determined for carrying out pattern printing”.

Thus, if “what kind of information is being claimed” is to be ascertained or determined, one should or can refer to the above-mentioned parts of the “specification” according to the “normal practice” as quoted above with respect to Deller. Once the scope with which the claim terms are intended to cover has been determined, one can then make the comparison with the disclosure in Furuya.

Paragraphs [0034]-[0035] of Furuya are referred to in the Office Action. However, the critical portion of the disclosure as translated into English does not appear to correctly reflect the Japanese text of such reference which should be the “correct” basis for comparison. Lines 5-8 of the English translation of paragraph [0034] should correctly be understood to mean:

“The specification display seal 5 is arranged as follows. Namely, one or more of the specification display portions (display squares or rectangles) 6 are printed black. By making combinations of the number and location of the black-printed specification display portion 6, the specification of the printing tape and of the ribbon inside the tape cartridge 1 can be identified (emphasis added).”

Thus, contrary to what is stated in the Office Action, there is no disclosure of the “desired configuration information”. What is disclosed in Furuya is nothing but a possibility of combining the black-printed specification printing portions (squares

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or rectangles). Because there are 5 squares (6a-6e), there can be made a variety of combinations by utilizing the number of the black-printed squares (varying from 0 to 5) and the locations thereof. In other words, such squares 6a-6e either printed black or left un-painted (i.e., white) are nothing but the "information related to the physical properties of the mounted tape cartridge (which is referred to as 'conventional art' in the specification of this invention) and, therefore cannot be said to be equivalent to the 'desired configuration information in the meaning of the claims of this invention. The information to form the basis of the 'combination' of squares 6a-6e is nothing but the 'tape width', 'tape length', and 'class of tapes', etc. as disclosed at lines 8-10 of paragraph [0034]. Such items or pieces of information cannot be set by the user, while contrary is the case with this invention. Combination of such physical properties as the mounted tape cartridge will not lead one skilled in the art to the "desired configuration information, as in this invention.

Also enclosed is a page entitled "Difference between Furuya and this Invention which shows in diagrammatic fashion the difference between Furuya and the present invention.

In view of this, the claims of the present Application must be construed so as to clearly distinguish patentably over Furuya et al., taken alone or in combination with the various other cited references. This Application should be in condition for allowance in view of the explanation set forth above. Therefore, reconsideration and allowance are respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6846 to discuss the steps necessary for placing the application in condition for allowance.

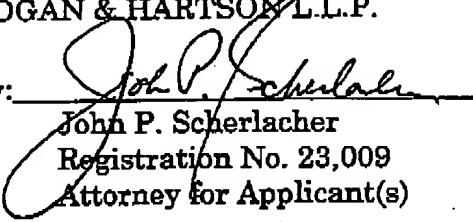
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Respectfully submitted,
HOGAN & HARTSON L.L.P.

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invention." This decision was approved in the Motion Picture Case (243 US 502, 61 L Ed 871, 37 S Ct 416, which further stated that the "scope of every patent is limited to the invention described in the claims contained in it. . . ." It was ruled in the Cimatti Case (198 US 399, 49 L Ed 1100, 25 S Ct 697) that an inventor in making his claim is "at liberty to choose his own form of expression, . . ." and that the courts "may not add or detract from the claim." In an earlier case of *Deering v Winona* (155 US 286, 39 L Ed 153, 15 S Ct 118), Mr. Justice Brown explained that if an inventor "claimed only a part of his invention, he is presumed to have abandoned the residue to the public." The Supreme Court also ruled that the inventor could claim nothing "beyond the claims" (95 US 274, 24 L Ed 344).

As a result of statutory law and decisional law, the conversion of the central definition to the peripheral definition of inventions was initiated and was subsequently accelerated by more exacting requirements of modern decisions—especially in recent years. Thus, in *White v Dunbar* (119 US 47, 30 L Ed 303, 7 S Ct 72), Mr. Justice Bradley stressed that: "*The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.*" And, in *Curtiss v Janin* (278 F 456), the court declared that: "All patentable inventions are defined by claims, but described, explained and disclosed by specification." In the Motion Picture Case, it was also pointed out that the claims "so mark where the progress claimed by the patent begins and where it ends that they have been aptly likened to the *description in a deed*, which sets the *bounds to the grant* which it contains." The same thought was expressed in *Kemode v United States* (145 USPQ 658) where the court said that "*the claims of a patent in order to be valid must define the patented invention with sufficient clarity that the metes and bounds thereof can be determined.*" The comparison of an invention to land was also made in *Consolidated v Wright* (94 US 92, 24 L Ed 68) and it was stated that:

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proaching that permitted in mechanical cases appears proper."

"We are of the opinion that the disclosure of the patent may be used under the circumstances to supplement the disclosure of this application, and that such disclosure taken in connection with that of the application constitutes a sufficient basis for claims of the scope under consideration." (Author's Italics.)

In the case of *Curtiss v Janin*, 278 F. 456, the court explained the function of the specification and the function of the claims. Undue breadth of disclosure is in the specification whereas undue breadth of claims is in the claims *per se*. The court stated that:

"All patentable inventions are defined by the claims, but described, explained and disclosed by the specification."

S 407. NEGATIVE DEFINITION OF OPERATING CONDITIONS

In *Ex parte Lilienfeld*, 11 USPQ 216, claim 11 was illustrative of the process claims and reads as follows:

"That improvement in rendering tobacco mild which consists in arranging previously aged and fermented tobacco in close proximity to a machine designed to produce ultra-violet ray and exposing the tobacco to the ultra-violet ray produced by the machine."

Process claims 17 and 18 contain negative definitions of operating conditions. The Board of Appeals referred to the negative expressions and stated that:

"Claims 17 and 18 are objected to because of the expressions, 'in the absence of extraneous heat' and 'without extraneous heat.' We do not feel that these expressions are objectionable. It may be that the idea sought to be recited in the claims could be expressed in a different manner but these limitations appear to us simply to set forth the idea of a normal temperature prevailing during the process." (Author's Italics.)

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protect the inventor, not in some paper ideal, but in his actual contribution to the useful arts."

In *Ex parte Davis and Swoope*, 34 USPQ 265, claim 2 was thought to be illustrative. It reads as follows:

"An improved process for producing condensation products valuable as pour inhibitors comprising the steps of bringing about a condensation of a material selected from the group consisting of a halogenated waxy hydro-carbon or olefins of the type derived from said halogenated hydro-carbons at a low condensation temperature under the influence of a catalyst of the aluminum chloride type, stopping the reaction before its normal conclusion whereby valuable inhibiting powers are preserved."

In reversing the Examiner, the Board of Appeals stated that:

"It is the examiner's view that claims 2 and 3 as drawn do not definitely distinguish from the Davis patent in that it is not understandable what might be embraced in the term 'normal' used in the claim. It seems to us that the purport of this term is obvious, especially when the claim is considered in the light of the specification. While it may be possible to define the time of reaction for a particular material under particular operating conditions, we do not feel that it would be feasible to draw a claim which more definitely sets forth the novel feature than the present claims. These claims read in the light of the specification, seem to us to be sufficiently definite to distinguish from the Davis patent and to warrant allowance." (Author's Italics.)

In *Ex parte Wilson and Newman*, 71 USPQ 213, claims relating to a method of producing zinc yellow were on appeal. The Board thought claim 12 to be illustrative. This claim reads as follows:

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the drawing and specification. It is the drawing and specification that are defective; not the claim.

"It is of course to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and specification." (Author's Italics.)

See also *In re Cavallito et al*, 134 USPQ 370.

S 285. CLAIMS ARE DEFINITE IF, IN THE LIGHT OF THE SPECIFICATION, THEY TEACH WITH REASONABLE CLARITY WHAT THE PATENTEE CLAIMS AS HIS INVENTION

This is particularly applicable where adjectives, like "small," "high," etc., are used.

In *Flexwood Co. v Faussner & Co.*, 145 F2d 528 (CA 7), 64 USPQ 261, one of the claims in suit read:

"1. A material consisting of a flexible backing and a sheet of thin wood veneer glued thereto, the veneer being in a ruptured state wherein at least the face of the veneer is composed of a mass of small strands or filaments whose rupture contours follow the wood grain in close mesh with each other and cause the surface of the veneer to appear to be continuous when the material is laid flat." (Author's Italics.)

Judge Barnes stated:

"The word 'small' might without the context be considered indefinite and to lack particularity and distinctness, but in the light of those portions of the specifications of 1,819,775, which we have set forth and italicized in the note-hereto cannot, in our opinion, properly be subjected to that criticism."

In *Crosley Corp v Westinghouse Elect. and Mfg.* 52 F Supp 884 (DC WD Pa), 59 USPQ 466, Judge Gibson stated that claim 3 of patent 2,242,335 was sufficiently definite

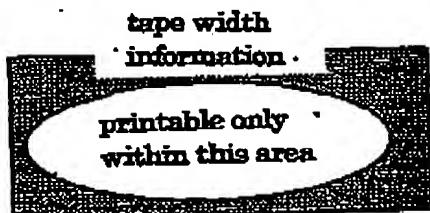
"since . . . the meaning of the words 'widely' . . . is clear from the context and the disclosure on which they are based."

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Difference between Furuya and This Invention

Furuya

Tape cartridge information (tape width, etc.) is arranged to be born on the tape cartridge itself. In other words, there is attached to the tape cartridge a limiting information to the effect that "this tape cartridge can be printed only under a specific condition." For example, if the maximum tape width is set to be 12mm, the printing exceeding 12mm is physically prohibited.



This Invention

Arbitrarily selected information which can be freely selected by the user from among the printing variations can be arranged to be born on the tape cartridge.

The user can prepare his own detection label so that the tape cartridge can be varied to a limited purpose.

